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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,138	09/10/2001	Atsushi Sugiyama	534037MO	9406

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EXAMINER

SAUCIER, SANDRA E

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/926,138

Applicant(s)  
Sugiyama

Examiner  
Sandra Saucier

Art Unit  
1651

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim 1, drawn to a first method, a method of removing non-cyclic adenine nucleotides from a sample comprising treating the sample with apyrase, alkaline phosphatase and adenosine deaminase.

Group II, claims 2-9, drawn to a second method, a method of determining cAMP content in a sample comprising:

- a) treating the sample with apyrase, alkaline phosphatase and adenosine deaminase,
- b) converting cAMP into AMP,
- c) determining the amount of AMP.

Group III, claims 10-20, drawn to a third method, a method of determining cAMP content in a sample comprising:

- a) treating the sample with apyrase, alkaline phosphatase and adenosine deaminase,
- b) converting cAMP into AMP
- c) converting ATP into F-6-P,
- d) converting F-6-P into 6-phosphogluconolactone and NADPH and
- e) determining the amount of NADPH.

Group IV, claim 21, drawn to a first composition, a kit comprising a (1) vial containing apyrase, alkaline phosphatase and adenosine deaminase, (2) vial containing phosphodiesterase, (3) a vial containing glycogen, phosphoric acid, glycogen phosphorylase, phosphoglucomutase, G-6-P dehydrogenase and NADP<sup>+</sup>.

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Group V, claim 22, drawn to a second composition, a kit comprising a (1) vial containing apyrase, alkaline phosphatase and adenosine deaminase, (2) vial containing phosphodiesterase, ATP, myokinase, phosphoenolpyruvic acid and pyruvate kinase, (3) a vial containing fructose, hexokinase, phosphoglucose isomerase, G-6-P dehydrogenase and NADP<sup>+</sup>.

An international or national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the of following combinations of categories;

- (1) a product and a process specially adapted for the manufacture of said product; or
- (2) a product and a process of use of said product; or
- (3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) a process and a apparatus specifically designed for carrying out said process; or
- (5) a product, a process specially adapted for the manufacture of the said product and an apparatus specifically designed for carrying out said process. 37 CFR 1.475.

The groups of inventions III and IV fall within category (2), a first appearing product and a method of use of that product. Thus, at most, inventions III and IV might be considered to

PCT Rule 13 does not provide for multiple compositions or multiple methods of use within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and the additional composition and method claims each constitute a separate group.

Further, the inventions listed as Groups III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the composition comprising (1) vial containing apyrase, alkaline phosphatase and adenosine deaminase, (2) vial containing phosphodiesterase, (3)

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a vial containing glycogen, phosphoric acid, glycogen phosphorylase, phosphoglucomutase, G-6-P dehydrogenase and NADP<sup>+</sup> is disclosed in Tables 6 and 7 of US 5,618,665 see search report.

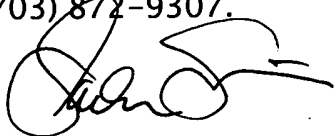
The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT Rule 13.2). Thus, a feature found in the prior art cannot be considered to be a special technical feature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 6:00 PM Monday and Tuesday and 8:30 AM-12:30 PM on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. **Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198.** The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier  
Primary Examiner  
Art Unit 1651  
March 5, 2003